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| 09/985,798 | 11/06/2001 | Masaharu Saito | 040679-1384 | 4319 |
| 22428 | 7590 | 12/02/2003 | EXAMINER | |
| FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | CORRIGAN, JAIME W | |
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| | | | 3748 | |

DATE MAILED: 12/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,798

Applicant(s)

SAITO ET AL.

Examiner

Jaime W Corrigan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 17-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 5,6,9 and 10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

This Office Action is in response to the Amendment filed on 12 September 2003. Claims 7-8, 12 have been amended. Claims 19-20 have been added. Claims 5-6, 9-10 are Non-elected. Overall, claims 1-20 are pending in this application. The arguments with respect to the reference applied in the first Office Action were not deemed persuasive. A final rejection is set forth below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 4, 11, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Lichti et al. (PN 6,308,672).

Regarding claim 1 Lichti discloses a drive force transmitter (See Figure 1 (17)) driven by means of a crank shaft (See Abstract) of the internal combustion engine; a cam shaft (See Figure 1 (21)) having an external periphery which is formed with a drive cam for operating a valve (See Abstract) of the internal combustion engine, the cam shaft being so fitted with the drive force transmitter as to rotate the drive force transmitter relative (See Column 2 Lines 39-56) to the cam shaft when so required, the cam shaft being a follower which is rotated with a drive force transmitted from the drive

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force transmitter (See Abstract); a housing (See Figure 3 (22)) rotating integrally with one of the drive force transmitter and the cam shaft; a vane rotor (See Figure 4 (28)) housed in the housing, and rotating integrally with the other of the drive force transmitter and the cam shaft; an advanced angle chamber (See Figure 5 (33)) and a delayed angle chamber (See Figure 5 (35)) disposed in the housing, and rotating the vane rotor with an oil pressure (See Abstract); an oil pressure conveyer (See Figure 3 (14)) communicating to the advanced angle chamber and the delayed angle chamber, the oil pressure conveyer supplying the oil pressure selectively (See Abstract, Column 4 Lines 15-28) to one of the advanced angle chamber and the delayed angle chamber while draining the oil pressure selectively from the other of the advanced angle chamber and the delayed angle chamber; a protrusion shaft (See Figure 3 (The part located between (56) and (46) that touches (46))) formed on at least one of the vane rotor (See Figure 3 (28)) and the housing, the protrusion shaft protruding forward; a target plate (See Figures 1, 3 (46)) mounted on at least the one of the vane rotor (See Figure 3 (28)) and the housing (See Figure 3 (22), (40)), the target plate being formed substantially flat (See Figure 3 (46)) and fitted to the protrusion shaft (See Figure 3 (The part located between (56) and (46) that touches (46))); and a sensor (See Figures 1, 3 (48)) disposed in a vicinity of the target plate, the sensor detecting a rotational angle (See Column 3 Lines 54-58) of the target plate.

Regarding claim 4 Lichti discloses the target plate (See Figure 1 (46)) has an internal periphery and an external periphery, the external periphery facing the sensor and being thinner (See Figure 3 (46)) than the internal periphery.

Regarding claim 11 Lichti discloses the drive force transmitter is a chain sprocket (See Figure 1 (17)).

Regarding claim 19 Lichti discloses the target plate (See Figures 1, 3 (46)) is a member different from the protrusion shaft (See Figure 3 (The part located between (56) and (46) that touches (46))).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichti et al. (PN 6,308,672) in view of legal precedence.

Lichti discloses the invention as recited in claim 1 above and further discloses the target plate (See Figure 3 (46)) is fixed to the protrusion shaft (See Figure 3 (Not numbered but clearly visible)) through a press fitting.

With regard to the limitation of "through a press fitting", a product by process claim which is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an unobvious difference between the two. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

Claims 17, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Magner et al.* (PN 5,736,633) in view of *Lichti et al.* (PN 6,308,672).

Magner discloses a plurality of detector protrusions (See Figure 1a (14) (16), ((18), (20)) protruding radially outward and disposed at regular (See Figure 1a) angular intervals circumferentially on the target plate (See Figure 2a (10)), the detector protrusions being substantially equal (See Figure 1a) in width, each two of the detector protrusions defining therebetween a first pulse interval (See Figure 1a (28), (30)) of a detection signal, and one index protrusion (See Figure 1a (12)) protruding radially outward and disposed between two (See Figure 1a (14), (20)) of the detector protrusions that are predetermined and adjacent to the one index protrusion, the one index protrusion being substantially equal in width (See Figure 1a (12), (14), (20)) to any one of the detector protrusions, the one index protrusion and the any one of the detector protrusions defining therebetween a second pulse interval (See Figure 1a (30), (36)) of the detection signal, the second pulse interval being shorter than the first pulse interval (See Figure 1a (28), (30), (26)).

Magner fails to disclose a flat target plate fixed to the protrusion shaft and the target plate is a member different from the protrusion shaft.

Lichti teaches it is conventional in the art to utilize a protrusion shaft (See Figure 3 (The part located between (56) and (46) that touches (46))); and a target plate (See Figure 3 (46)) fixed to the protrusion shaft, the target plate being formed substantially flat (See Figure 3 (46)) and the target plate (See Figure 3 (46)) is a member different from the protrusion shaft (See Figure 3 (The part located between (56) and (46) that touches (46))).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the protrusion shaft taught by Lichti in the Magner device since it would provide improved stability of the target plate.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Magner in view of Lichti as applied to claim 17 above, and further in view of legal precedence.

Magner discloses the invention as recited in claim 17 above and further discloses the target plate (See Figure 3 (46)) is fixed to the protrusion shaft (See Figure 3 (Not numbered but clearly visible)) through a press fitting.

With regard to the limitation of "through a press fitting", a product by process claim which is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an unobvious difference between the two. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

Allowable Subject Matter

Claims 7-8, 12-16 are allowed.

Response to Arguments

Applicant's arguments filed 12 September 2003 have been fully considered but they are not persuasive.

In response to Applicant's arguments regarding a monolithic protrusion shaft and target plate as applied to independent claims 1, 17. The Examiner would like to point out that the protrusion shaft (See Figure 3 (The part located between (56) and (46) that touches (46)) and target plate (See Figures 1, 3 (46)) of Lichti are separate members.

In response to Applicant's argument regarding the external and internal peripheries as applied to dependent claim 4. It appears to the Examiner, based on the drawings, that the external periphery is thinner than the internal periphery. The Examiner would also like to point out that this claim can additionally be rejected under case law regarding Change in Size (See *In re Rose*, 105 USPQ 237 (CCPA 1955)) or Change in Shape (See *In re Dailey*, 149 USPQ 47 (CCPA 1966)).

In response to Applicant's argument regarding the target wheel in Lichti is not press fitted to the protrusion shaft as applied to dependent claims 2-3. The Examiner would like to point to language in the legal precedence rejection of claims 2-3 where it is stated that "a product by process claim which is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon

the applicants to come forward with evidence establishing an unobvious difference between the two."

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication from the examiner should be directed to Examiner Jaime Corrigan whose telephone number is (703) 308-2639. The examiner can normally be reached on Monday - Friday from 8:30 a.m. – 6:00 p.m. 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion, can be reached on (703) 308-2623. The fax number for this group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

JC

Jaime Corrigan

Jaime Corrigan

Patent Examiner

November 26, 2003

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Thomas Denion

THOMAS DENION

SUPERVISORY PATENT EXAMINER
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